

Albany
Atlanta
Brussels
Denver
Los Angeles

**McKenna Long
& Aldridge^{LLP}**
Attorneys at Law

1900 K Street, NW • Washington, DC 20006-1108
Tel: 202.496.7500 • Fax: 202.496.7756
www.mckennalong.com

TTAB

New York
Philadelphia
Sacramento
San Diego
San Francisco
Washington, D.C.

KRISTIN H. LANDIS
(202) 496-7124

EMAIL ADDRESS
klandis@mckennalong.com

November 30, 2007

BY HAND DELIVERY

Trademark Trial and Appeal Board
United States Patent and Trademark Office
600 Dulany Street
Madison East, Concourse Level, Room C-55
Alexandria, VA 22313-1451

TRADEMARK PROCESS
RECEIVED
2007 NOV 30 P 2:01
US PATENT &
TRADEMARK OFFICE


**Re: Cancellation Number 92046037
Bryan Corporation v. Novatech SA
Our Ref.: 25114.0008**

79008374

Dear Sir/Madam:

Enclosed please find Petitioner's Motion to Compel Discovery Responses from Registrant for the above-referenced cancellation. Please return the enclosed copy USPTO date stamped. Thank you.

Sincerely yours,


Kristin H. Landis

KHL:kh



11-30-2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,093,389
Registered May 16, 2006

BRYAN CORPORATION,)	
)	
Petitioner,)	
)	Cancellation No. 92046037
)	
v.)	
)	
NOVATECH SA,)	
)	
Registrant.)	
)	

**PETITIONER BRYAN CORPORATION'S
MOTION TO COMPEL DISCOVERY RESPONSES FROM NOVATECH SA**

Pursuant to 37 C.F.R. § 2.120(e), Petitioner Bryan Corp. moves to compel discovery responses from Registrant Novatech SA ("Novatech"). Bryan Corp. previously filed a motion to compel on March 7, 2007. Despite the Board's attached September 28, 2007 Discovery Order compelling Novatech to answer Bryan Corp.'s fifth interrogatory in its Second Set of Interrogatories ("Interrogatory No. 5"), Novatech has failed to supply Bryan Corp. with any response. Because Novatech's answer to Interrogatory No. 5 goes directly to Bryan Corp.'s claim that Novatech fraudulently declared (as part of its Section 66(a) trademark application) that Novatech is entitled to use the trademark STERITALC in commerce, the Board to should require Novatech to meaningfully respond to Interrogatory No. 5 within 10 days of this motion.¹

¹ Bryan Corp. has contacted Novatech's counsel and indicated that this motion would not be filed if the overdue interrogatory response was provided. Novatech's counsel did not respond before this motion was filed.

DISCUSSION

As discussed more fully in Bryan Corp.'s Motion to Compel Discovery Responses filed March 7, 2007, Petitioner Bryan Corp. filed a petition on July 11, 2006, seeking cancellation of Novatech's trademark STERITALC on, among other things, the ground that Novatech committed fraud upon the United States Patent and Trademark Office when it stated that it believed it had the right to use STERITALC in United States commerce. Thus, at issue is in this cancellation proceeding is whether Novatech, at the time it filed its application for registration, believed or had a reasonable belief that it had the lawful right to use the STERITALC mark in commerce. *See, e.g., Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205 (T.T.A.B. 2003).

On November 10, 2006, in an effort to determine Novatech's state of mind at the time of filing its registration, Bryan Corp. served Novatech with Interrogatory No. 5, that requested Novatech to:

State whether your belief that you are "entitled to use" the STERITALC mark in commerce, as set forth in the Declaration you signed in connection with your application Serial No. 79/008,374, means that on the date of the Declaration you believed you have the right to sell a drug that bears the name STERITALC in U.S. commerce.

See Ex. 1. Novatech improperly objected to this contention interrogatory on the ground that it calls for a legal conclusion and/or that it calls for information protected by the attorney client privilege, thereby precipitating Bryan Corp.'s original Motion to Compel Discovery Responses.

See Ex. 1. In that motion, Bryan Corp. correctly argued that an interrogatory that is otherwise proper is not objectionable merely because it requires a party to give an opinion or contention that relates to fact or application of law to fact. *See* Fed. R. Civ. P. 33(b), and *Johnson Pump/General Valve, Inc. v. Chromalloy American Corp.*, 10 U.S.P.Q.2d 1671, 1676 (T.T.A.B.

1978). On September 28, 2007, the Board agreed with Bryan Corp. and granted its Motion to Compel with respect to Interrogatory No. 5. *See* Ex. 2.

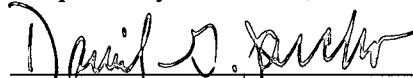
Although it has now been over two months since the Board ordered Novatech to provide Bryan Corp. with an answer as to why Novatech believed that it has a lawful right to use the STERITALC mark in commerce, Novatech has yet again failed to provide Bryan Corp. with any response. Because Novatech's state of mind goes directly to the central question before the Board (*i.e.*, whether Novatech fraudulently registered its STERITALC mark) Novatech should be required to supply Bryan Corp. with the information it seeks. Accordingly, the Board should compel Novatech to amend its discovery responses within 10 days of this motion.

CONCLUSION

Based on foregoing, the Board should grant Bryan Corp.'s Motion to Compel Discovery Responses from Novatech.

Dated: November 30, 2007

Respectfully submitted,



Daniel G. Jarcho, Esq.

Andrew J. Park, Esq.

Kristin H. Landis, Esq.

MCKENNA LONG & ALDRIDGE, LLP

1900 K St. NW

Washington, DC 20006

Attorneys for Petitioner Bryan Corporation

CERTIFICATE OF SERVICE

I hereby certify that on this 30th day of November, 2007, a copy of the foregoing document was served, by first class mail, postage prepaid, upon:

John S. Egbert, Esq.
Egbert Law Offices
State National Building
412 Main Street
7th Floor
Houston, TX 77002




EXHIBIT 1

Petitioner Bryan Corp.
Cancellation No. 92046037

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,093,389
Registered on: May 16, 2006

BRYAN CORPORATION,

Petitioner,

v.

NOVATECH SA,

Registrant.

§
§
§
§
§
§
§
§
§

Cancellation No. 92046037

**REGISTRANT'S RESPONSE TO PETITIONER'S SECOND SET OF
INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, NOVATECH SA ("Registrant"), by its attorneys, hereby submits the following objections and responses to BRYAN CORPORATION'S ("Petitioner") Second Set of Interrogatories as follows:

GENERAL OBJECTIONS

1. Registrant objects to Petitioner's Interrogatories to the extent they seek information subject to the attorney/client privilege, or within the attorney's work product immunity, or other grounds of immunity from discovery.
2. Registrant objects to Petitioner's Interrogatories to the extent they seek information that is unreasonably cumulative, duplicative, or obtainable from some other source that is more convenient, less burdensome, or less expensive.
3. Registrant objects to Petitioner's Interrogatories to the extent that the burden or expense of the Interrogatory outweighs its likely probative value.

information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner.

4. State whether the drug label you submitted as evidence of the use of the STERITALC mark in connection with application Serial No. 75/076,198 is a sample of a label that was affixed to drugs sold in U.S. commerce.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory cannot be expected to yield information relevant to the allegations of the complaint, to the proposed relief, or to the defenses of Petitioner. Without waving these objections or any others, Applicant will supplement this interrogatory with relevant, non-privileged information responsive to this Interrogatory if such an answer is able to be determined.

5. State whether your belief that you are "entitled to use" the STERITALC mark in commerce, as set forth in the Declaration you signed in connection with your application Serial No. 79/008,374, means that on the date of the Declaration you believed you have the right to sell a drug that bears the name STERITALC in U.S. commerce.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. The STERITALC mark was filed under 66(a) as an intent to use application and was based on an international registration.

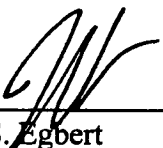
6. State whether your belief that you are "entitled to use" the STERITALC mark in commerce, as set forth in the Declaration you signed in connection with your application Serial No. 79/008,374, means that on the date of the Declaration you believed you possess ownership of the name STERITALC.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for a legal conclusion. The interrogatory calls for information that is protected by the Attorney/Client privilege. Also, The interrogatory is an improper attempt to require Registrant to list all factual assertions or contentions in this case, marshal all of its available proof, or marshal all proof Registrant intends to offer.

Respectfully submitted,

Date

12-13-06



John S. Egbert
Reg. No. 30,627
Egbert Law Offices
412 Main St., 7th Floor
Houston, Texas 77002
(713)224-8080
(713)223-4873 fax

ATTORNEY FOR REGISTRANT
NOVATECH SA

EXHIBIT 2

Petitioner Bryan Corp.
Cancellation No. 92046037

received
10-2-07

UNITED STATES PATENT AND TRADEMARK
OFFICE

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA

Mailed: September 28, 2007

Cancellation No. 92046037

Bryan Corporation

v.

Novatech SA

Jyll S. Taylor, Administrative Trademark Judge:

This case now comes up for consideration of respondent's motion to compel responses to its first and second set of requests for production, filed March 5, 2007, and petitioner's motion to compel discovery responses, filed March 7, 2007. Each party opposes the other's motion to compel.¹

Background

The parties' motions to compel each require us to consider certain regulations and actions of the U.S. Food and Drug Administration ("FDA"), and the impact, if any, of

¹ Respondent's request for a telephone conference was only made at the very end of its motion. The request is denied as the parties' motions to compel in this case are not appropriate for a telephone conference, and in any event have been fully briefed. The parties are directed to the Board's notice regarding telephone conferences, available on its Web site: <http://www.uspto.gov/web/offices/com/sol/og/2000/week25/pattele.htm>.

those regulations and actions on discovery in this proceeding. Therefore, it is necessary to briefly consider the FDA-related allegations at issue in this proceeding.

In its petition for cancellation, petitioner alleges that respondent's registration of the mark STERITALC for certain pharmaceutical products should be cancelled because it was procured by fraud. According to petitioner, respondent declared in its intent to use application for registration of STERITALC that it "believed it was entitled to use the mark in commerce," but, according to petitioner, respondent "did not then and still has not obtained [the allegedly required] approval from [the FDA] to distribute its product in commerce or to use the name STERITALC." Petitioner further alleges that respondent's mark STERITALC is likely to be confused with petitioner's mark STERILE TALC POWDER, that petitioner has priority of use and that petitioner would be damaged by the continued registration of respondent's mark. While respondent denies the salient allegations in the petition for cancellation, its motion to compel also alleges that FDA regulations and actions are relevant to this proceeding.

Respondent's Motion to Compel

In its motion to compel, respondent makes several relatively specific claims about the alleged deficiencies in petitioner's discovery responses. First, respondent claims

Cancellation No. 92046037

that "[p]etitioner argues throughout its Petition for Cancellation that it is the sole holder of common law trademark rights to the term STERILE TALC POWDER based on the [FDA] approval of a drug with such a name," but "[p]etitioner has failed to produce, among other things, all documents and things dealing with the FDA approval of its two New Drug Applications ("NDA") for sterile talc powder products." Next, respondent asserts that petitioner should produce "documents evidencing the business relationship and the joint venture pursued by Petitioner and Registrant," as well as "information regarding the use of the term STERILE TALC POWDER within [petitioner's] SCLEROSOL" NDA. Finally, respondent claims that petitioner should produce documents relating to the FDA's "label detail requirements," and documents "showing the generic name of Petitioner's SCLEROSOL product."

Respondent also makes an unexplained, general claim that "Petitioner has not produced all documents responsive to [Document Request Nos.] 3, 25, 30, 33, 35 and 37" in respondent's First Set of Requests for Production. These requests for production seek documents relating to petitioner's adoption and use of STERILE TALC POWDER, the "language or word origin" of the mark, actual confusion between the parties' marks and "any inquiry investigation,

Cancellation No. 92046037

or survey" conducted by petitioner relating to this proceeding.

In its opposition to the motion to compel, petitioner claims that the requests for documents relating to the NDAs for STERILE TALC POWDER and SCLEROSOL are "overly broad," unduly burdensome, irrelevant and not likely to lead to the discovery of relevant admissible information. Specifically, petitioner disputes respondent's assertion that the petition for cancellation is based on the FDA's approval of petitioner's products. Rather, petitioner argues, the petition for cancellation is based on fraud and likelihood of confusion between STERILE TALC POWDER and STERITALC. Petitioner's claim of common law rights in STERILE TALC POWDER is based on use of the mark in commerce, not FDA approval, and "FDA approval is only a necessary prerequisite to use in commerce, not use in commerce *per se*." Petitioner also claims that the mark SCLEROSOL "is not relevant" to this proceeding. Finally, petitioner argues that it has produced all documents in its possession, or that it has no responsive, non-privileged documents, related to the adoption and use of STERILE TALC POWDER, "the FDA's approval of the STERILE TALC POWDER mark," actual confusion, the parties' prior business relationship or any "inquiry, investigation or survey" concerning this proceeding.

In its reply, respondent argues that whether or not the petition for cancellation is "based on" FDA approval of STERILE TALC POWDER, "it is undeniable that Petitioner has claimed 'superior common law right to use of the STERILE TALC POWDER,' and that such a right was allegedly received only after FDA approval of the STERILE TALC POWDER NDA." Respondent also claims that SCLEROSOL is relevant to this proceeding because, as illustrated by the FDA's Web site, "the generic name for [SCLEROSOL] is 'sterile talc powder,'" and "evidence showing 'sterile talc powder' is the generic name of Petitioner's SCLEROSOL drug is quite relevant in determining whether Petitioner holds an alleged common law interest."

Petitioner's Motion to Compel

In its motion to compel, petitioner argues that respondent has failed to produce information and documents, which, petitioner alleges, are relevant to petitioner's fraud claim. Specifically, petitioner alleges that respondent failed to adequately respond to discovery requests concerning the FDA approval process for respondent's drug sold under the mark STERITALC.

According to petitioner, "only *lawful* use in commerce is recognized by the PTO as a basis for granting trademark rights," and "for the use of a drug such as STERITALC to be lawful it must comply with the Federal Food, Drug and

Cosmetic Act ("FDCA")." Therefore, petitioner alleges, respondent "improperly failed to produce" documents and information relating to the FDA's denial of respondent's request to market and sell STERITALC (First Set of Interrogatories, No. 4 and First Set of Document Requests, No. 1). Petitioner also alleges that given respondent's assertion that it distributed STERITALC under an Investigational New Drug Application ("IND") procedure in 1996, respondent failed to adequately respond to discovery requests "regarding the details of any STERITALC clinical investigation, treatment IND, or treatment protocol" (Third Set of Document Requests Nos. 1, 5-7, and Third Set of Interrogatories Nos. 1, 3). Petitioner claims that respondent failed to produce information or documents "regarding sale of STERITALC" in the U.S. or regarding respondent's "use of the STERITALC mark and label in U.S. commerce" (Second Set of Interrogatories Nos. 2, 4, Third Set of Document Requests Nos. 2-4, 8, 10 and 11, Third Set of Interrogatories Nos. 2, 4, 5, 9, 11). Finally, petitioner argues that respondent improperly objected to its interrogatory concerning respondent's stated belief in its trademark application that it is entitled to use STERITALC (Second Set of Interrogatories No. 5).

In response to petitioner's motion, respondent argues that "[t]he FDA denial of Registrant's NDA [in 1997] is not

at issue in this case since the STERITALC mark was filed under 66(A) on a bona fide intent-to-use basis" in 2004. Respondent also argues that petitioner's requests for information and documents concerning the 1996 IND procedure constitute a "fishing expedition" for material which "could only be relevant for use in a forum other than this" Board proceeding. Finally, respondent alleges that its answer to the petition for cancellation and responses to petitioner's interrogatories adequately answer petitioner's Second Set of Interrogatories No. 5, which concerns respondent's stated belief in its trademark application that it is entitled to use STERITALC.

In reply, petitioner argues that information related to respondent's NDA and the IND procedure for STERITALC is reasonably calculated to lead to the discovery of admissible evidence, because even though respondent's application for registration was based on an intent to use the mark, respondent represented to the Office that "it had the 'right to use' STERITALC in commerce." According to petitioner, respondent's "understanding of FDA rules is indisputably relevant to whether [respondent] knew, at the time it declared otherwise, that it did not have the right to use STERITALC in commerce." Petitioner also alleges that respondent has not adequately responded to petitioner's Second Set of Interrogatories No. 5.

Decision

Because each party argues that the FDA's approval, or lack of approval, of the parties' marks and pharmaceutical products is relevant, we must first consider the impact of FDA decisions on Board proceedings. The issue has been addressed before. See, General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992); Kellogg Co. v. New Generation Foods, Inc., 6 USPQ2d 2045 (TTAB 1988); Clorox Co. v. Armour-Dial, Inc., 214 USPQ 850 (TTAB 1982); Santinine Societa v. P.A.B. Produits, 209 USPQ 958 (TTAB 1981).

As a preliminary matter, as petitioner points out in its motion to compel, "for the use of a drug such as STERITALC to be lawful it must comply with the Federal Food, Drug, and Cosmetic Act ("FDCA")."

It has been the consistent position of this Board and the policy of the Patent and Trademark Office that a "use in commerce" means a "lawful use in commerce," and the shipment of goods in violation of federal statute, including the [FDCA], may not be recognized as the basis for establishing trademark rights.

Clorox Co., 214 USPQ at 851. Therefore, evidence that either party offered its product in violation of the FDCA could be relevant to the allegations and defenses in this proceeding.

However, "[t]he PTO and FDA reviews [of pharmaceutical trademarks] serve two fundamentally different purposes." J.

Cancellation No. 92046037

Thomas McCarthy, Trademarks and Unfair Competition § 19:150 (4th ed. 2007). Furthermore, because the Board has "little or no familiarity" with the FDCA or other federal regulatory acts over which it does not have jurisdiction, "there is a serious question as to the advisability of our attempting to adjudicate whether a party's use in commerce is in compliance with the particular regulatory act or acts which may be applicable thereto." Santinine, 209 USPQ at 964.

Accordingly,

the better practice in trying to determine whether use of a mark is lawful under one or more of the myriad regulatory acts is to hold a use in commerce unlawful only when the issue of compliance has previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a statute regulating the sale of a party's goods.

General Mills, 24 USPQ2d at 1273.

In this case, we note that neither party has submitted evidence of a previous determination of noncompliance by the FDA with respect to use of either party's mark. Nor has either party submitted evidence of a per se violation of the FDCA or other regulatory statute or rule. Therefore, we cannot on the record before us compel responses to discovery requests concerning FDA regulations or actions, given that this is a proceeding concerning only whether the STERITALC trademark registration should be cancelled.

Turning first to respondent's motion to compel, and pursuant to the discussion above, we **DENY** respondent's motion to compel petitioner to produce additional information or documents regarding FDA review, approval or communications concerning: (1) NDAs for sterile talc powder products; (2) STERILE TALC POWDER; (3) SCLEROSOL; and/or (4) "label detail requirements." Our denial encompasses respondent's request that petitioner be compelled to produce "documents showing the generic name of Petitioner's SCLEROSOL product."

Furthermore, with respect to respondent's First Request for Production Nos. 3, 25, 30 and 37, petitioner "submits that it possesses no additional documents responsive" to these requests, and accordingly respondent's motion to compel additional information or documents concerning the parties' prior agreements or relationship, petitioner's adoption and use of its mark, the word origin of petitioner's mark or actual confusion, is **DENIED**.²

Petitioner claims that it has no documents responsive to respondent's First Request for Production No. 33 which are not protected by the attorney work product doctrine.

² Of course, either party may seek to preclude the other from relying on information or documents which should have been produced in response to valid discovery requests, but were not, on this or any other topic. See, Presto Products v. Nice-Pak Products, 9 USPQ2d 1895, 1896 n. 5 (TTAB 1988).

Cancellation No. 92046037

Accordingly, respondent's motion to compel the production of documents responsive to this request is **DENIED**. However, the parties are required to serve on each other a proper privilege log pursuant to Fed. R. Civ. P. 26(b)(5) for any documents withheld based on the attorney-client privilege or attorney work product doctrine.

Finally, because the stipulated protective order filed with the Board on November 30, 2006 is now in effect, to the extent that petitioner withheld any documents based solely on its objection that the documents are proprietary or confidential, those documents must be produced in accordance with the protective order.

Turning next to petitioner's motion to compel, and pursuant to the discussion above, we **DENY** petitioner's request that respondent be compelled to produce documents or information related to: (1) any NDA; (2) any IND; (3) the FDA's approval or denial of respondent's request to market or sell STERITALC; and/or (4) any STERITALC clinical investigation or treatment protocol. This denial encompasses petitioner's request that respondent be compelled to reply more fully to petitioner's First Set of Document Requests No. 1, First Set of Interrogatories No. 4, Third Set of Document Requests Nos. 1, 2-4, 5-8, 10 and 11, and Third Set of Interrogatories Nos. 1-5, 9 and 11.

Cancellation No. 92046037

Petitioner's motion to compel a substantive response to its Second Set of Interrogatories Nos. 2 and 4 is **DENIED**, because sales made under, and specimens submitted in connection with, respondent's cancelled Registration No. 2116833 are not relevant to this proceeding, which involves only Registration No. 3093389.

Finally, petitioner's motion to compel a substantive response to its Second Set of Interrogatories No. 5 is **GRANTED**, and respondent's objection to the interrogatory as calling for a "legal conclusion" is **OVERRULED**. See, Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671, 1676 (TTAB 1989).

Conclusion

Respondent's motion to compel is **DENIED**. Petitioner's motion to compel is **GRANTED** with respect to its Second Set of Interrogatories No. 5, but otherwise **DENIED**. The parties are required to serve on each other proper privilege logs pursuant to Fed. R. Civ. P. 26(b)(5) for any documents withheld based on the attorney-client privilege or attorney work product doctrine. To the extent that either party withheld documents based solely on a confidentiality objection, those documents must be produced in accordance with the stipulated protective agreement in effect in this proceeding.

Cancellation No. 92046037

Proceedings herein are resumed, and trial dates are
reset as follows³:

Discovery to Close:	CLOSED
30-day testimony period for party in position of plaintiff to close:	January 1, 2008
30-day testimony period for party in position of defendant to close:	March 1, 2008
15-day rebuttal testimony period to close:	April 15, 2008

³ Petitioner's motion to extend the testimony period, filed March 8, 2007, will not be further considered, inasmuch as we consider the filing of respondent's motion to compel on March 5, 2005 to have effectively tolled the running of this proceeding.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,093,389
Registered May 16, 2006

BRYAN CORPORATION,)	
)	
Petitioner,)	
)	Cancellation No. 92046037
)	
v.)	
)	
NOVATECH SA,)	
)	
_____ Registrant.)	

**ORDER GRANTING PETITIONER BRYAN CORP.'S MOTION TO COMPEL
DISCOVERY RESPONSES FROM REGISTRANT NOVATECH SA**

Upon consideration of Petitioner's Motion to Compel Discovery Responses from
Registrant Novatech SA and it appearing for good cause shown,

IT IS HEREBY ORDERED this ____ day of _____, 2007 that Petitioner
Bryan Corp.'s Motion to Compel is **GRANTED**.

Registrant Novatech SA is to serve on Petitioner Bryan Corp. a response to Petitioner's
Second Set of Interrogatories No. 5 within 10 days of this Order:

SO ORDERED.

THE BOARD